

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 27, 2007 ("Office Action"). At the time of the Office Action, Claims 1-20 were pending in the application. In the Office Action, the Examiner rejects Claims 1-20. Applicants respectfully request reconsideration and favorable action in this case.

Nonstatutory Double Patenting Rejections

The Examiner provisionally rejects Claims 1-20 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-21 of copending Application No. 10/807,566. Without conceding the veracity of any double patenting rejection, but instead solely for the purpose of moving this case expediently to issuance, Applicant files herewith a Terminal Disclaimer obviating the double patenting rejection.

Section 103 Rejections

Claims 1-6, 8-12, 14-18, and 20

A. The Proposed Combination of *Ide* and *Ishida* Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1

The Examiner rejects Claims 1-6, 8-12, 14-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,598,187, issued to Ide et al. ("*Ide*"), in view of U.S. Patent App. No. 2004/0061621, issued to Ishida ("*Ishida*"). Applicants respectfully traverse these rejections.

Applicants respectfully submit that the combination of *Ide* and *Ishida* proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants' claims. For example, consider Claim 1. It recites a handheld device comprising:

a control module operable to track movement of the handheld device using the motion detection module, to compare the tracked movement against the remote command gestures to determine a matching gesture, and to identify the one of the commands corresponding to the matching gesture; and
a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device.

The Examiner relies on Col. 14, lines 7-47 of *Ide* to teach these elements. See Office Action, p. 5. *Ide* states that movements are converted "into digital signals, which are supplied to the

motion recognizing section 41.” *Ide*, Col. 14, lines 31-32. Then, “the motion recognizing section 41 first converts the signals indicating movements with two directions into motion pattern data in the same format as that of the basic data....Then, a motion code indicating the corresponding basic motion pattern is acquired.” *Ide*, Col. 14, lines 37-43. Finally, the control target device receives the code, and “the control target device executes a control process according to the given code.” *Ide*, Col. 14, lines 46-48. In Claim 1, the *identified command* is delivered to the remote device. In *Ide*, a code is sent to the remote device and then the device must “execute[] a control process according to the given motion code.” *Ide*, Col. 14, lines 46-48. In response to Applicants’ previous argument that *Ide* fails to disclose “a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device,” the Office Action states that “the motion code indicating the corresponding basic motion pattern is the identified command.” Office Action, p. 8. *Ide*, however, does not associate “command” with “code.” Multiple codes can be sent in *Ide*, and the target device “may carry out a suitable operation on the basis of the given pairs of data items.” *See Ide*, Col. 14, line 63 to Col. 15, line 1. Multiple codes do not necessarily create multiple commands, as the two are separate and distinct. Therefore, *Ide* does not disclose, teach, or suggest “a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device.” *Ishida* does not cure this deficiency. For this reason, Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 2-6 depend from Claim 1 and are allowable for at least the reasons discussed above. For analogous reasons, independent Claims 8, 14, and 20 and their respective dependent claims are allowable under 35 U.S.C. 103(a). Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1, 8, 14, and 20 and all claims depending therefrom.

B. The Proposed *Ide-Ishida* Combination is Improper

The rejection of Applicants’ claims is also improper because it would not be obvious to combine *Ide* and *Ishida* in the manner the Examiner proposes. The rejected claims are allowable for at least this reason.

1. The Obviousness Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See* M.P.E.P. § 2143.01. It is clear based at least on the distinction discussed above that the proposed *Ide-Ishida* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. In fact, portions of *Ide* teach away from Claim 1 as set forth above. Respectfully, it appears that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

2. It Would Not be Obvious to Combine *Ide* and *Ishida*

According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of *Ide* to have a display as taught by *Ishida* such that a user can control the device while viewing the build-in monitor ([0013], [0041] of *Ishida*).” Office Action, p. 6. Applicants respectfully submit that the Examiner's assertion that it would have been obvious to combine the teachings of *Ide* with the teachings of *Ishida* to purportedly arrive at Applicants' invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

In response to Applicant's previous argument that there is no motivation to combine *Ide* and *Ishida*, the Office Action states that "Ishida clearly provided reasons to combine and provide for a monitor on the remote control device." Office Action, p. 8. The mere fact that references can be combined or modified does not render the resultant combination obvious

unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01. Thus, the fact that the teachings of one reference would improve the teachings of another reference does not provide the required suggestion to combine or modify. Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See* M.P.E.P. § 2143.01. Even if *Ishida* does provide for a monitor on the control device, *Ide* clearly teaches away from any combination that places a monitor on the spatial control device as described in *Ide*. *Ide* refers to the input device as a “spatial control mouse” and repeatedly thereafter as a “mouse.” A conventional mouse (for example, the well-known ball mouse or optical mouse used with a personal computer) does not include a built-in display. Also, a mouse is typically used to move a cursor on a screen. As *Ide* states, “the operator moves the mouse on the desk to move the cursor interlocking with the mouse movement to the desired object...appearing on the display. With the cursor positioned over the desired object on the display, he clicks (or releases) an acknowledge switch called a click button of the mouse to enter data to the system.” *Ide*, Col. 1, lines 21-28. This means that when using the mouse, the user watches the screen to track the movement of the cursor, while the user’s hand is on the mouse. There is therefore no motivation to put a viewable display on the mouse because the user rarely has reason to look away from the screen and toward the mouse while using the mouse. Using a three-dimensional input device as described by *Ide* is similar. *Ide* says, “The operator moves the three-dimensional input device in space to move the cursor interlocking with the movement of the input device to the desired object on the screen.” *Ide*, Col. 1, lines 52-58. Further, the user’s hand covers the majority of the surface of a mouse, so any viewable display on the mouse would be largely blocked from the user’s view while the user was operating the mouse. Because of these well-known attributes of its use, there is no motivation to include a viewable display on an input device as described by *Ide*, and the cited references teach away from such a combination.

Accordingly, since the prior art teaches away from the proposed combination it would not be obvious to combine *Ide* with *Ishida* in the manner the Examiner proposes. Applicants respectfully submit that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for

demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection of these claims be withdrawn.

Claims 7, 13, and 19

The Examiner rejects Claims 7, 13, and 19 under 35 U.S.C. 103(a) as being unpatentable over *Ide*, in view of *Ishida*, and further in view of WO 01/86920 issued to Lapidot ("*Lapidot*"). Applicants respectfully traverse these rejections.

For the reasons discussed above, Applicants submit that the combination of *Ide* and *Ishida* does not disclose, teach, or suggest all elements specifically recited in Applicants' Claim 1. *Lapidot* does not cure this deficiency. Claim 7 depends from Claim 1, and Claims 13 and 19 both depend from independent claims with limitations similar to Claim 1. For this reason, Applicants respectfully request reconsideration and allowance of Claims 7, 13, and 19.

For the reasons discussed above, Applicants also submit that there is no motivation to combine or modify the *Ide* or *Ishida* references in the manner the Examiner proposes. *Lapidot* does not cure this deficiency. For at least these reasons, Applicants respectfully submit that the rejection of these claims be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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